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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,569	07/21/2003	Takashi Sasaki	3673-0153P	4795
2292	7590	07/19/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				GORDON, RAEANN
ART UNIT		PAPER NUMBER		
		3711		

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/622,569	SASAKI ET AL.
	Examiner Raeann Gorden	Art Unit 3711
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>07 May 2004</u> .		
2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-3 and 5-10</u> is/are pending in the application.		
4a) Of the above claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-3 and 5-10</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>21 July 2003</u> is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.		
If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:		
1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.		
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.		
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).		
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____.		

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al (5,967,908) in view of Yamagishi et al (5,779,563). In regards to claims 1 and 6, Yamagishi '908 discloses a golf ball comprising a core and a cover. Applicant claims the cover of the instant invention has at least 10% or more dimples with a B/T ratio less than 0.70. Applicant defines B as the difference between the cover layer thickness and the depth of the dimple. T is defined as the thickness of the cover. Table 3, dimple set I of Yamagishi discloses a B value of 0.325 mm. Since the cover may be 0.5 mm (fig 1), the difference is $0.5\text{ mm} - 0.175\text{ mm} = 0.325\text{ mm}$ or B. The thickness of the cover or T is 0.5 mm. Therefore the B/T value is 0.65. The quantity of the dimples with a B/T of 0.65 is 276 or 70%. Yamagishi discloses the cover material is not limited and may be made from any well-known cover stocks. Yamagishi does not disclose polyurethane as an option. However, Yamagishi '563 teaches a cover layer made from a thermoplastic polyurethane elastomer. In regards to claims 3 and 8, over 70% of the dimples in dimple set I have a B/T ratio of 0.65 or less, which is less than the mean of 0.86 claimed by applicant. In regards to claims 6 and 9,

the cover is harder than the intermediate layer (fig 1). See table 4, examples 2 and 3 where the cover hardness is at least 5 units higher than the intermediate layer. In regards to claims 5 and 10, the Shore D hardness of the intermediate layer is from 53 to 60 (fig 1). One of ordinary skill in the art would have modified the cover material for increased durability.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/373,100 in view of Yamagishi et al (5,779,563). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '100 application claim identical features except the polyurethane cover. However, Yamagishi teaches a three piece golf ball comprising

a polyurethane cover. One of ordinary skill in the art would have included a polyurethane cover to increase the durability.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant argues the Examiner's analysis of the prior Yamagishi '908 is incorrect. Applicant further provides a chart alleging the examples of the 908 patent falls outside the ranges claimed by Applicant. While applicant has calculated the tables in the 908 patent using the data provided in the tables, as clearly pointed out by the Examiner in the previous action the thickness of the cover was taken from the remaining disclosure of the patent. Yamagishi clearly discloses dimple depths within applicant's ranges as well as cover thicknesses. Although the examples cite one possibility the remaining disclosure cannot be ignored. Yamagishi provides the dimple depth in the example and also cites a cover thickness of 1.5 for the examples. However, the disclosure makes clear that any cover thickness from 0.5 to 3.0 mm may be used. Therefore the reference clearly discloses and suggests the claimed invention. In regards to Yamagishi '563, the secondary reference, it is assumed Applicant does not disagree with the combination of the references since arguments were not advanced in the response.

With respect to the double patenting rejection, Applicant's arguments are not persuasive. As stated by Applicant, the only difference between the present invention

and the '100 application is the cover material. Applicant should also note, the material of the cover in the '100 application is not claimed, therefore the comparison in the arguments are not understood. However, if applicant intends or has modify the '100 application to limit the cover to an ionomeric material the following response is applicable. Ionomers and polyurethanes are commonly used for golf ball cover and interchanging the two is not outside the capability of one skilled in the art.

Applicant's request for an explanation of the cited references is not understood. It should be abundantly clear the references are cited because they are golf balls comprising detailed dimples and are relevant to applicant's invention. Furthermore, 2003/0186761 is published application 10/373,100, which is cited above in the double patenting rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raeann Gorden
Primary Examiner
Art Unit 3711

Rg
July 15, 2004